UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/701,029	11/04/2003	Brian Grove	200634-0029-00-US(408195)	6164

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EXAMINER
SHIFERAW, ELENI A

ART UNIT	PAPER NUMBER
2436	

NOTIFICATION DATE	DELIVERY MODE
08/18/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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	Application No.	Applicant(s)
Office Action Summary	10/701,029	GROVE ET AL.
	Examiner	Art Unit	
	ELENI A. SHIFERAW	2436	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>04 June 2010</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>34,36-44,49,51-59,64 and 66-74</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>34,36-44,49,51-59,64 and 66-74</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____ .

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

1.   Claims 34, 36-44, 49, 51-59, 64 and 66-74 are pending, claims 1-33 were withdrawn and

claims 35, 45-48, 50, 60-63, 65, and 75-78 are currently cancelled.

Response to Amendments/Argument

2.   The 112 rejection to claims 34 and 49 is withdrawn in view of applicant's amendment.

3.   The 112 rejection to claims 37, 52 and 67 is withdrawn in view of applicant's

amendment.

4.   The 112 rejection to claims 49 and 51-59 is withdrawn in view of applicant's

amendment.

5.   The indicated allowability of claims **34, 36-44, 49, 51-59, 64 and 66-74** is withdrawn in

view of the newly discovered application/reference(s) rejected under obviousness type double

patenting 12641586. Rejections based on the newly cited reference(s) follow; however if

Terminal disclaimer is filed all pending claims would be allowable.

Double Patenting

6.   The nonstatutory double patenting rejection is based on a judicially created doctrine

grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

harassment by multiple assignees.   A nonstatutory obviousness-type double patenting rejection

is appropriate where the conflicting claims are not identical, but at least one examined

application claim is not patentably distinct from the reference claim(s) because the examined

application claim is either anticipated by, or would have been obvious over, the reference

claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re*

Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225

USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163

USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may

be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

ground provided the conflicting application or patent either is shown to be commonly owned

with this application, or claims an invention made as a result of activities undertaken within the

scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal

disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR

3.73(b).

7.   Claims 34, 36-44, 49, 51-59, 64 and 66-74 are provisionally rejected on the ground of

nonstatutory obviousness-type double patenting as being unpatentable over claim 34, 36-43, 49,

51-58, 64, and 66-74 of copending Application No.12641586. Although the conflicting claims

are not identical, they are not patentably distinct from each other because the instant case, all

elements of claims 34, 36-44, 49, 51-59, 64 and 66-74 correspond to the claims of the copending

claims and encompass the scope of claims 34, 36-44, 49, 51-59, 64 and 66-74 of the instant

application.

Instant application 10701029	Copending application 12641586
34. A method of authenticating a hardware token for operation with a host comprising; retrieving a value X from a memory separate from the hardware token, the memory accessible to an authenticating entity, the value X generated from a non-varying computer fingerprint F of a host and an identifier P securing access to the hardware token, wherein the fingerprint F is computed at least in part from non-varying host information C based on a unique characteristic of the host; regenerating the same identifier P at least in part from the value X and the fingerprint F; and transmitting the regenerated identifier P to the hardware token to authenticate the hardware token for operation with the host.	34. A method of authenticating a hardware token for operation with a host, comprising: retrieving a value X from a memory accessible to an authenticating entity, the value X generated from a non-varying computer fingerprint F of a host and an identifier P securing access to a hardware token, wherein the fingerprint F is computed at least in part from non-varying host information C based on a unique characteristic of the host; regenerating the same identifier P at least in part from the value X and the fingerprint F; and transmitting the regenerated identifier P to the token to authenticate the token for operation with the host.
36. (Previously Presented) The method of claim 34, wherein the fingerprint F is computed at least in part from the host information C and a non-varying server specific value V.	36. The method of claim 34, wherein the fingerprint F is computed at least in part from the host information C and a non-varying server specific value V.
37. (Currently Amended) The method of claim 34 claim 36, wherein the fingerprint F is computed at least in part from the host information C, [[a]] the non-varying server specific value V and a non-varying string Z.	37. The method of claim 34, wherein the fingerprint F is computed at least in part from the host information C, a non-varying server specific value V and a non-varying string Z.
38. (Currently Amended) The method of claim 34, wherein the value X is computed in the hardware token.	38. The method of claim 34, wherein the value X is computed in the token.
39. (Original) The method of claim 34, wherein the value X is computed according to	39. The method of claim 34, wherein the value X is computed according to X=f(P, F), wherein f(P, F) is a reversible function such that f(f(P,

X =f(P, F), wherein f(P, F) is a reversible function such that f(f(P, F), F) = P.	F), F)=P.
40. (Original) The method of claim 39, wherein f(P, F) comprises P XOR F.	40. The method of claim 39, wherein f(P, F) comprises P XOR F.
41. (Original) The method of claim 34, wherein the value X is further computed at least in part from a user identifier U.	41. The method of claim 34, wherein the value X is further computed at least in part from a user identifier U.
42. (Original) The method of claim 41, wherein the value X is computed according to X =f(P, U, F), wherein f(P, U, F) is a reversible function such that f(f(P, U, F), U, F) = P.	42. The method of claim 41, wherein the value X is computed according to X=f(P, U, F), wherein f(P, U, F) is a reversible function such that f(f(P, U, F), U, F)=P.
43. (Original) The method of claim 42, wherein f(P, U, F) is P XOR U XOR F.	43. The method of claim 42, wherein f(P, U, F) is P XOR U XOR F.
44. (Currently Amended) The method of claim 34, wherein: the authenticating entity is the host computer, communicatively coupleable to the <u>hardware</u> token; and the value X is stored in the host computer.	44. The method of claim 34, wherein: the authenticating entity is the host computer, communicatively coupleable to the token; and the value X is stored in the host computer.
49. (Currently Amended) An apparatus for authenticating a hardware token for operation with a host, comprising: ~~means for retrieving a value X from~~ a memory separate from [[a]] the hardware token, the memory accessible to an authenticating entity, <u>the memory_ storing a value X,</u> the value X generated from a non-varying computer fingerprint F of [[a]] the host and an identifier P securing access to the <u>hardware</u> token, wherein the fingerprint F is computed at least in part from non-varying host information C based on a unique characteristic of the host; <u>the host, adapted to:</u> <u>compute the fingerprint F, send the fingerprint F to the hardware token, receive the value X from the hardware token</u> <u>store the value X in the memory, retrieve the value X from the memory,</u> <u>regenerate</u> means for regenerating the same identifier P at least in part from the retrieved	49. An apparatus for authenticating a hardware token for operation with a host, comprising: means for retrieving a value X from a memory accessible to an authenticating entity, the value X generated from a non-varying computer fingerprint F of a host and an identifier P securing access to a hardware token, wherein the fingerprint F is computed at least in part from non-varying host information C based on a unique characteristic of the host; means for regenerating the same identifier P at least in part from the value X and the fingerprint F; and means for transmitting the regenerated identifier P to the token to authenticate the token for operation with the host.

value X and the fingerprint ~~F;~~ and ~~means~~ for transmitting transmit the regenerated identifier P to the hardware token to authenticate the hardware token for operation with the host; and the hardware token, adapted to: receive the fingerprint F from the host, generate the value X from the fingerprint F and the identifier P, transmit the value X to the host for storage in the memory, and receive the regenerated value P from the host, whereby the hardware token is authenticated for operation with the host.	
51. (Previously Presented) The apparatus of claim 49, wherein the fingerprint F is computed at least in part from the host information C and a non-varying server specific value V.	51. The apparatus of claim 49, wherein the fingerprint F is computed at least in part from the host information C and a non-varying server specific value V.
52. (Currently Amended) The apparatus of ~~claim cl 9~~ claim 51, wherein the fingerprint F is computed at least in part from the host information C, [[a]] the non-varying server specific value V and a non-varying string Z.	52. The apparatus of claim 49, wherein the fingerprint F is computed at least in part from the host information C, a non-varying server specific value V and a non-varying string Z.
53. (Currently Amended) The apparatus of claim 49, wherein the value X is computed in the hardware token.	53. The apparatus of claim 49, wherein the value X is computed in the token.
54. (Original) The apparatus of claim 49, wherein the value X is computed according to X =f(P, F),wherein f(P, F) is a reversible function such that f(f(P, F), F) = P.	54. The apparatus of claim 49, wherein the value X is computed according to X=f(P, F), wherein f(P, F) is a reversible function such that f(f(P, F), F)=P.
55. (Original) The apparatus of claim 54, wherein f(P, F) comprises P XOR F.	55. The apparatus of claim 54, wherein f(P, F) comprises P XOR F.
56. (Original) The apparatus of claim 49, wherein the value X is further computed at least in part from a user identifier U.	56. The apparatus of claim 49,wherein the value X is further computed at least in part from a user identifier U.
57. (Original) The apparatus of claim 56, wherein the value X is computed according to X =f(P, U, F) ,wherein f(P, U, F) is a reversible function such that f(f(P, U, F), U, F) = P.	57. The apparatus of claim 56, wherein the value X is computed according to X=f(P, U, F), wherein f(P, U, F) is a reversible function such that f(f(P, U, F), U, F)=P.
58. (Original) The apparatus of claim 57, wherein f(P, U, F) is P XOR U XOR F.	58. The apparatus of claim 57, wherein f(P, U, F) is P XOR U XOR F.

59. (Currently Amended) The apparatus of claim 49, wherein: the authenticating entity is the host computer, communicatively coupleable to the <u>hardware </u>token; and the value X is stored in the host computer.	59. The apparatus of claim 49, wherein: the authenticating entity is the host computer, communicatively coupleable to the token; and the value X is stored in the host computer.
64. (Previously Presented) An apparatus for authenticating a hardware token for operation with a host, tile apparatus comprising a processor and a Computer readable storage medium storing instructions for performing steps comprising: retrieving a value X from a memory separate from [[a]] the hardware token, the memory accessible to an authenticating entity, the value X generated from a non-varying computer fingerprint F of a host and an identifier P securing access to the <u>hardware</u> token, wherein the fingerprint F is computed at least in part from non-varying host information C based on a unique characteristic of the host; regenerating the same identifier P at least in part from the value X and the fingerprint F; and transmitting the regenerated identifier P to the hardware token to authenticate the hardware token for operation with the host.	64. An apparatus for authenticating a hardware token for operation with a host, the apparatus comprising a processor and a computer readable storage medium storing instructions for performing steps comprising: retrieving a value X from a memory accessible to an authenticating entity, the value X generated from a non-varying computer fingerprint F of a host and an identifier P securing access to a hardware token, wherein the fingerprint F is computed at least in part from non-varying host information C based on a unique characteristic of the host; regenerating the same identifier P at least in part from the value X and the fingerprint F; and transmitting the regenerated identifier P to the token to authenticate the token for operation with the host.
66. (Previously Presented) The apparatus of claim 64, wherein the fingerprint F is computed at least in part from the host information C and a non-varying server specific value V.	66. The apparatus of claim 64, wherein the fingerprint F is computed at least in part from the host information C and a non-varying server specific value V.
67. (Currently Amended) The apparatus of <s>claim 64 </s>claim 66, wherein the fingerprint F is computed at least in part from the host information C, [[a]] the non-varying server specific value V and a non-varying string Z.	67. The apparatus of claim 64, wherein the fingerprint F is computed at least in part from the host information C, a non-varying server specific value V and a non-varying string Z.
68. (Currently Amended) The apparatus of claim 64, wherein the value X is computed in the <u>hardware </u>token.	68. The apparatus of claim 64, wherein the value X is computed in the token.
69. (Original) The apparatus of claim 64,	69. The apparatus of claim 64, wherein the value

wherein the value X is computed according to X =f(P, F), whereinf(P, F) is a reversible function such thatf(f(P, F), F) = P.	X is computed according to X=f(P, F), wherein f(P, F) is a reversible function such that f(f(P, F), F)=P.
70. (Original) The apparatus of claim 69, wherein f(P, F) comprises P XOR F.	70. The apparatus of claim 69, wherein f(P, F) comprises P XOR F.
71. (Original) The apparatus of claim 64, wherein the value X is further computed at least in part from a user identifier U.	71. The apparatus of claim 64, wherein the value X is further computed at least in part from a user identifier U.
72. (Original) The apparatus of claim 71, wherein the value X is computed according to X = f (P, U, F) ,wherein f(P, U, F) is a reversible function such that f(f(P, U, F), U, F) = P.	72. The apparatus of claim 71, wherein the value X is computed according to X=f(P, U, F), wherein f(P, U, F) is a reversible function such that f(f(P, U, F), U, F)=P.
73. (Original) The apparatus of claim 72, wherein f(P, U, F) is P XOR U XOR F.	73. The apparatus of claim 72, wherein f(P, U, F) is P XOR U XOR F.
74. (Currently Amended) The apparatus of claim 64, wherein: the authenticating entity is the host computer, communicatively coupleable to the hardware token; and the value X is stored in the host computer.	74. The apparatus of claim 64, wherein: the authenticating entity is the host computer, communicatively coupleable to the token; and the value X is stored in the host computer.

8.   This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9.   *Claims 34, 36-44, 49, 51-59, 64 and 66-74 of the instant application would have been obvious, to one ordinary skill in the art at the time of the invention was made, over claims 34, 36-43, 49, 51-58, 64, and 66-74 of the copending application 12641586 because using similar wording in a different application does not make the application/invention distinct and each limitation of the claims of the instant application are anticipated/equivalent by the claims 34, 36-43, 49, 51-58, 64, and 66-74 of the copending application and encompass the scope of claims 34, 36-44, 49, 51-59, 64 and 66-74 of the instant application.*

Conclusion

10.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELENI A. SHIFERAW whose telephone number is (571)272-3867. The examiner can normally be reached on Mon-Fri 6:00am-2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser R. Moazzami can be reached on (571) 272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eleni A Shiferaw/
Primary Examiner, Art Unit 2436